



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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REPLY TO OFFICE ACTION

Claims 1, 5, and 9-14 are pending in the application. In the Office Action, the Examiner provisionally rejected claims 1, 5, and 9-14 under the judicially created doctrine of double patenting over claims 1-25 of copending application Serial No. 09/993,708 (the '708 application). The Examiner also rejected claims 1, 5, and 9-14 under 35 U.S.C. § 103(a) as unpatentable over Mano et al. (U.S. Patent No. 5,319,700) in view of Seazholtz et al. (U.S. Patent No. 6,424,636) and rejected claims 1, 5, and 9-14 under 35 U.S.C. § 103(a) as unpatentable over Mano in view of Yoshida (U.S. Patent No. 5,943,364).

Applicant thanks the Examiner for granting a telephone interview with Applicant's representative on September 7, 2004. During the interview, Applicant's representative discussed with the Examiner the provisional rejection of claims 1, 5, and 9-14 under the judicially created doctrine of double patenting over claims 1-25 of copending application Serial No. 09/993,708 (the '708 application). Additionally, Applicant's representative discussed with the Examiner the rejections of claims 1, 5, and 9-14 under 35 U.S.C. § 103(a) as unpatentable over Mano in view of Seazholtz and as unpatentable over Mano in view of Yoshida.

Applicant respectfully traverses the Examiner's double patenting rejection, and note that it appears to be the same rejection set forth in the Office Action dated February 17, 2004. In Applicant's Reply dated March 30, 2004, Applicant noted that since the '708 application is pending, no double patenting circumstances can arise. Accordingly, since no patent has apparently issued from the '708 application, Applicant respectfully requests, as in the prior Reply, that the provisional rejection of claims 1, 5, and 9-14 be withdrawn and any resolution in the form of a Terminal Disclaimer be deferred.

In addition, as noted in the prior Reply, Applicant also notes that M.P.E.P. § 804 addresses the situation of two copending applications. The section indicates that "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application . . . unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. If the 'provisional' double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a

patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent." See M.P.E.P. § 804. For at least this additional reason, Applicant requests that any resolution in the form of submission of a Terminal Disclaimer, if necessary, be deferred. Should the provisional double patenting rejection remain as the only rejection in the present application, then the Examiner should withdraw the rejection.

Applicant respectfully traverses the rejections of claims 1, 5, and 9-14 under 35 U.S.C. § 103(a) as unpatentable over Mano in view of Seazholtz and as unpatentable over Mano in view of Yoshida. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Applicant's claim 1 recites "an interface unit" including, among other things, "a first transmitter configured to transmit a type query signal to the telephone terminal at the low speed," "a second transmitter configured to transmit a speed change request to the telephone terminal at the low speed and change a transmission speed from the low speed to the high speed if the received type signal indicates that the telephone terminal

is capable of transmitting data at the high speed; a detector configured to determine whether data is transmitted from the telephone terminal at the high speed or the low speed; and a speed change unit configured to change a transmission speed from the high speed to the low speed when the detector determines that the data is transmitted from the telephone terminal at the low speed.” Mano, Seazholtz, and Yoshida, whether taken alone or in combination, do not disclose or suggest at least these features.

In rejecting claim 1, the Office Action fails to address the claimed “detector” and “speed change unit.” See Office Action, pages 3-4. Since the Examiner must show that the references, taken alone or combined, teach or suggest each and every element recited in the claims, the rejection is improper for at least this reason. See M.P.E.P. § 2143.03 (8th ed. 2001).

The Examiner has also not shown that Mano teaches or suggests “a detector configured to determine whether data is transmitted from the telephone terminal at the high speed or the low speed; and a speed change unit configured to change a transmission speed from the high speed to the low speed when the detector determines that the data is transmitted from the telephone terminal at the low speed,” as recited in claim 1.

By contrast, the system in Mano is a terminal adapter pooling system that uses a terminal adapter to enable communications between an ISDN and a plurality of data terminals. See col. 2, lines 4-9. The Mano system reduces a data load applied to a central control unit for calling party signal transmission and the called party number signal reception. Mano, however, is silent regarding at least the claimed “detector” and “speed change unit” recited in claim 1.

Moreover, the Examiner concedes that Mano fails to teach the claimed first and second transmitters, but relies on Seazholtz allegedly for such teachings. Applicant respectfully disagrees, and notes that Seazholtz also at least fails to disclose or suggest the claimed “detector” and “speed change unit.” Accordingly, Applicant respectfully submits that claim 1 is allowable over the Examiner’s proposed combination of references at least for this reason as well.

Turning to Seazholtz, the Examiner contends that it teaches first and second transceivers used to change speed. See Office Action, page 4. The system in Seazholtz, however, includes a dedicated microprocessor/controller that controls each ADSL/AVR transceiver by loading firmware to set up variable transmission rates, initiates startup, re-start and test modes, monitors signal quality, and determines to change the transmission rate if and when an appropriate option is enabled. See col. 11, lines 30-36. The variable transmission rates are controlled by sets of program instructions loaded into a chip set and may be pre-designated or selected automatically. See col. 11, lines 34-52.

The Seazholtz system, which controls transmission speeds based on a dedicated microprocessor residing in each transceiver, thus differs from Applicant’s claimed invention. In particular, Seazholtz does not disclose or suggest at least “a second transmitter configured to transmit a speed change request to the telephone terminal at the low speed and change a transmission speed from the low speed to the high speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the high speed,” as recited in claim 1.

The Examiner also contends that it would have been obvious to modify the terminal adapter taught by Mano to use programmable transceivers taught by Seazholtz so that one could change transceiver rates by using 2B1Q line encoding taught by Seazholtz (See Office Action, pages 4 and 5). However, the Examiner has not offered any rationale indicating Mano supports 2B1Q line encoding. Nor does 2B1Q line encoding have any relevance to the claims. For at least these reasons, one of ordinary skill in the art would not be motivated to combine Seazholtz with Mano.

The Examiner also rejected claims 1, 5, and 9-14 based on a combination of Mano and Yoshida. In this rejection, as in the prior rejection, the Examiner concedes that Mano fails to teach the claimed first and second transmitters, but relies on Yoshida allegedly for such teachings. Applicant respectfully disagrees, and notes that Yoshida also at least fails to disclose or suggest the claimed “detector” and “speed change unit.” Accordingly, Applicant respectfully submits that claim 1 is allowable over the Examiner’s proposed combination of references at least for this reason as well.

The Examiner also alleges Yoshida teaches using a control circuit for changing settling criteria of the baud rate and the bit rate of a modem using a control signal. See Office Action, page 6. This allegation, however, does not make up for the deficiencies of Mano.

By contrast, the Yoshida system merely includes a control circuit for changing setting criteria of the baud rate and the bit rate of a modem, and does not make up for the shortcomings of Mano. See Abstract. For example, as shown in Fig. 1, the Yoshida system includes modem 8, which is controlled by control circuit 20. The Yoshida system, however, does not teach or suggest at least “a first transmitter

configured to transmit a type query signal to the telephone terminal at the low speed” and “a second transmitter configured to transmit a speed change request to the telephone terminal at the low speed and change a transmission speed from the low speed to the high speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the high speed,” as recited in claim 1.

In addition, the Examiner contends that it would have been obvious for one of skill in the art to modify Mano to include the control circuit taught by Yoshida for the benefit of sending parameter signals to control transmission rates (See Office Action, pages 6 and 7). As noted above, however, both Mano and Yoshida fail to teach at least the claimed combination including “a first transmitter configured to transmit a type query signal to the telephone terminal at the low speed” and “a second transmitter configured to transmit a speed change request to the telephone terminal at the low speed and change a transmission speed from the low speed to the high speed if the received type signal indicates that the telephone terminal is capable of transmitting data at the high speed,” as recited in claim 1. Accordingly, even if Mano and Yoshida were combined in the manner proposed by the Examiner, the references would fail to teach each and every element of claim 1.

For at least these reasons, Mano, Seazholtz, and Yoshida, taken alone or in combination, do not disclose or suggest all of the features of claim 1.

Independent claims 5, 9, 10, 12, and 14, while of a differing scopes, include recitations similar to claim 1. Claims 5, 9, 10, 12, and 14 are allowable over Mano, Seazholtz, and Yoshida at least for the reasons discussed above in regard to claim 1.

Dependent claims 11 and 13 disclose additional features that are neither suggested nor disclosed by the applied prior art, either individually, or in combination. Claims 11 and 13 are therefore allowable at les due to their dependence from claims 10 and 12, respectively.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 9, 2004

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